

ADMINISTRATIVE PANEL DECISION

ABG Volcom LLC v. Web Commerce Communications Limited, Client Care Case No. D2023-3059

1. The Parties

The Complainant is ABG Volcom LLC, United States of America (“United States”), represented by Authentic Brands Group, United States.

The Respondent is Web Commerce Communications Limited, Client Care, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <volcomnz.com> is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 17, 2023. On July 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 19, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (John Doe) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 19, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on the same day.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 17, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 18, 2023.

The Center appointed Theda König Horowicz as the sole panelist in this matter on September 6, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a United States-based company established in 1991. The Complainant commercializes and promotes a range of clothing inspired by surfing, skateboarding, and snowboarding culture in North America, Europe, Asia, South America and the Middle East.

The Complainant is the owner of the registrations worldwide for the mark VOLCOM and VOLCOM + STONE DEVICE logo including in New Zealand, *inter alia*:

- VOLCOM Stone Device on black background trademark registration No. 627554, in class 25, registered on May 24, 2001; and
- VOLCOM trademark registration No. 236073, in class 25, registered on July 26, 1996.

The Complainant also owns and operates the website to which the domain name <volcom.com> resolves. The Complainant is also very active in social media.

The disputed domain name was registered on November 14, 2022. It is currently inactive.

5. Parties' Contentions

A. Complainant

The Complainant alleges to have rights over the trademarks VOLCOM and a Stone Logo. The disputed domain name is identical or confusingly similar to the Complainant's registered trademarks. The addition of the geographical abbreviation "nz" is insufficient to distinguish the Respondent's disputed domain name from the Complainant's mark.

The Complainant alleges that the Respondent has not been licensed, contracted or otherwise permitted by the Complainant in any way to use the VOLCOM or Stone Logo trademark or to apply for any domain name incorporating the VOLCOM trademark, nor has the Complainant acquiesced in any way to such use or application of the VOLCOM trademark by the Respondent. Furthermore, there has been no evidence that the Respondent is using or plans to use the Complainant's trademarks or the disputed domain name for a *bona fide* offering of goods or services. According to the Complainant, the disputed domain name resolves to a copycat website selling the Complainant's products without its authorization, but is now inactive. The use of the VOLCOM trademarks in the disputed domain name and on the website is likely to trick consumers into wrongly believing in an association with the Complainant.

The Complainant claims registration is in bad faith since the Respondent was well aware of the Complainant's trademarks at the time of registration. The Complainant notes that its trademarks are well known around the world. Furthermore, a simple Google search would have disclosed the Complainant's marks and business which have been existing since more than 30 years. Additionally, the Respondent used a privacy service to register the disputed domain name which is another indication of bad faith. Finally, the Respondent is intentionally trying to pass off the disputed domain name as the Complainant's website to sell competing and unauthorized goods. Thus, the Respondent is intentionally trying to create a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

According to paragraph 15(a) of the Rules, the Panel shall decide the Complaint in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable.

Paragraph 4(a) of the Policy directs that a complainant must prove each of the following:

- (i) that the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) that the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) that the domain name has been registered and is being used in bad faith.

Paragraph 4(a) of the Policy states that the burden of proving that all these elements are present lies with the Complainant. At the same time, in accordance with paragraph 14(b) of the Rules, if a party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules, or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

A. Identical or Confusingly Similar

The Complainant has shown to have obtained trademark rights in VOLCOM in New Zealand.

According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's registered trademark VOLCOM since it contains this mark in entirety. The addition of the letters "nz" in the disputed domain name, most likely as a reference to New Zealand, does not prevent a finding of confusing similarity as the relevant trademark remains clearly recognizable within the disputed domain name. See section 1.8 of the [WIPO Overview 3.0](#).

The generic Top-Level Domain ("gTLD") ".com" is viewed as a standard registration requirement, and as such is typically disregarded under the first element confusing similarity test. See section 1.11.1 of the [WIPO Overview 3.0](#).

The Panel therefore finds that the conditions in paragraph 4(a)(i) of the Policy are fulfilled in relation to the disputed domain name.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances that may demonstrate when a respondent has rights or legitimate interests in a domain name. The list includes:

- (i) the use of the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) being commonly known by the domain name; or

- (iii) the making of a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers.

Once the Complainant establishes a *prima facie* case against the Respondent under this ground, the burden of production shifts to the Respondent to rebut it. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has made sufficient statements in order to demonstrate that the Respondent has no rights or legitimate interests in the disputed domain name.

In particular, the Complainant has not licensed or otherwise permitted the Respondent to use its trademarks. There is no evidence showing that the Respondent would be commonly known by the disputed domain name or that a legitimate business would be run by the Respondent under the disputed domain name.

The Panel therefore finds that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name and the burden of production shifts to the Respondent who has chosen not to reply.

The Respondent has not rebutted the Complainant's *prima facie* case, and there is no evidence of the types of circumstances set out in paragraph 4(c) of the Policy that might give rise to rights or legitimate interests in the disputed domain name on the part of the Respondent in these proceedings.

The Panel notes that the Complainant did not provide evidence as to the website to which the disputed domain name resolves. Currently the website is inactive.

This said, and as already stated before, nothing is contained in the present submissions which would show that the disputed domain name has been legitimately noncommercial or fairly used by the Respondent or that the Respondent would have any rights or legitimate interests in the disputed domain name.

Furthermore, the nature of the disputed domain name, incorporating the Complainant's distinctive VOLCOM trademark in its entirety with the mere addition of the letters "nz" as a reference to New Zealand does not show that the Respondent would have rights or legitimate interests in the disputed domain name and carries a risk of implied affiliation.

The Panel therefore finds that the conditions in paragraph 4(a)(ii) of the Policy are fulfilled in relation to the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires the complainant to prove both registration and use of the domain name in bad faith. Paragraph 4(b) of the Policy provides examples of circumstances which shall be evidence of registration and use in bad faith:

- (i) circumstances indicating that the respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the holder's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the holder's respondent's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the holder's respondent's website or location or of a product or service on the holder's respondent's website or location.

Accordingly, for the Complainant to succeed, the Panel must be satisfied that the disputed domain name was registered and is being used in bad faith.

Given the circumstances of the case, including the fact that the disputed domain name identically reproduces the Complainant's distinctive VOLCOM trademark without authorization, it is inconceivable to the Panel that the Respondent registered the disputed domain name without prior knowledge of the Complainant's trademark and business which is widely promoted worldwide through the Complainant's official website "www.volcom.com" and in social media.

In the absence of evidence provided by the Complainant as to the website to which the disputed domain name resolved and noting that the disputed domain name is currently inactive, the Panel cannot take position on the Complainant's assertions in this regard.

This said, the Panel notes that the Respondent has not contested the allegations made by the Complainant and his silence in these proceedings is an additional evidence of bad faith in these circumstances.

The Panel therefore finds that the conditions in paragraph 4(a)(iii) of the Policy is fulfilled in relation to the disputed domain name.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <volcomnz.com> be transferred to the Complainant.

/Theda König Horowicz/

Theda König Horowicz

Sole Panelist

Date: September 26, 2023